



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/147,398	04/02/99	KAULE	W JEK-KAULE

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QM12/0719

EXAMINER

CADUGAN, E

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 07/19/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Advisory Action**

Application No.

09/147,398

Examiner

Erica E Cadugan

Applicant(s)

KAULE ET AL.

Art Unit

3722

–The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

THE REPLY FILED 13 July 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☒ they raise the issue of new matter. (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

4. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 1-18,20-22,24,25 and 28-36.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.
9. ☒ The proposed drawing correction filed on 13 July 2001 a) ☐ has b) ☒ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
11. ☒ Other: Interview Summary, paper no. 11

WILLIAM BRIGGS  
PRIMARY EXAMINER

EEC 7/18/01

Continuation of 3. NOTE: As set forth in the specification as originally filed, applicant sets forth both tool tracks and substructures, and sets them forth as being two different things. As originally filed, applicant's specification (page 9, lines 14-27) described Figure 10 as having "an engraving consisting in the present case of flank 28 and engraving 29 located on the bottom" that was "brought into embossing plate 15". Applicant further stated that "[i]n an additional operation, additional information in the form of so-called sub- or microstructure lines 30 was brought into flank 28". Thus, the application as originally filed provided for "substructures" within the flanks of an engraving. As viewed in Figure 10 and described on page 9, lines 14-27 as originally filed, "engraving" 29 is shown as the engraving tool track itself, whereas "sub or microstructure lines 30" are shown and described as being an additional structure. Additionally, claim 25 as originally filed set forth that "the substructure is present on the bottom and/or at least one of the flanks of the depression", providing support as originally filed for the substructure to be provided on the bottom (i.e., not just on the flank) of a depression.

Applicant has indicated that "[n]ew Figure 14 has been added to more clearly show the meander shape or extension at least in partial areas parallel to a direction of the tool track line of claim 24". However, it is noted that claim 24 sets forth that the "substructure" (emphasis added) "is meander-shaped or extends at least in partial areas parallel to a direction of" the engraved depression line. What is shown in Figure 5(b), of which proposed Figure 14 is a section view, are tool tracks 12 and 17 (see page 5, last paragraph). There is no indication in the specification as originally filed that the tool tracks shown in Figure 5(b) further contain substructures such as the ones illustrated in Figure 10 and described on page 9, and there is particularly no indication in the specification as originally filed that the tool tracks shown in Figure 5(b) contain substructures that are "meander-shaped" or that extend "at least in partial areas parallel to a direction of said at least one line" as set forth in claim 24. Thus, applicant has not overcome the objection to the drawings. Regarding applicants' assertions that page 5, lines 24-27 and Figure 5(b) provide antecedent basis for the "meander shape", it is noted that the "meander shape" described and shown at the indicated location is of a tool track and not of a substructure. Regarding applicants' assertion that Figures 5(b) and (c) and page 5, line 26 to page 6, line 2 of the specification as originally filed provide antecedent basis for the phraseology "or extends at least in partial areas parallel to a direction of the contour line", again, it is noted that the indicated locations teach a tool track that extends as described, but do not teach substructures that extend as described. Regarding applicants' assertion that page 9, lines 11-13 provides support for the "machine-readable information", it is noted that what is set forth in claim 30 is that the "substructure" represents machine-readable information, and that there is nothing on page 9, lines 11-13 to indicate that the machine-readable information there-described is formed by the claimed substructures. Regarding applicants' assertion that "the substructure is executed in the form of grooves", it is noted that the indicated locations (Figures 6(b) and 6(c) and applicants' proposed addition to page 2, lines 7-18) indicate tool tracks that form grooves, and not substructures. Furthermore, applicant's addition to page 5, line 21 of the specification to page 6, line 2 of the specification that "Figure 13" (examiner is assuming that applicant properly meant --Fig. 14-- ) "is the three-dimensional cross sectional view of Fig. 5(b) taken at line 14-14, showing the meander-shaped substrate" constitutes new matter, because as previously stated, the specification as originally filed contained no indication that the tool tracks shown in Figure 5(b) contained any substructure or "substrate".

Continuation of 4. Applicant's reply has overcome the following rejection(s): Applicant's reply would have overcome many of the 35 USC 112, second paragraph rejections. Specifically, applicant's reply would have overcome all of the described antecedent basis problems, the issue described in the third paragraph of page 5 of the office action mailed April 13, 2001, and the issues described in the first and second paragraphs of page 6 of the office action mailed April 13, 2001. However, the 112, second paragraph rejection of claims 34-35 still applies. Applicant has asserted that "[i]t appears that the claims are complete since claims 34 and 35 clearly state what the use is". Note that claims 34 and 35 merely set forth the step of "using the intaglio printing plate", and it is unclear what precisely is encompassed by the verb "using". A claim is held to be indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986) and MPEP section 2173.05(q), for example.

Applicants' arguments with respect to the art rejections do not overcome the previous art rejections. See the office action mailed April 13, 2001. Regarding applicant's assertion that "[o]ne can create hypothetical situations, as the Examiner has done on page 8 of the Official Action ..." (page 7 of the proposed amendment), it is noted that at the indicated location, the Examiner is not creating hypothetical situations, but is outlining why the substructures could be considered to be in the form of the claimed "line", see the rejection in question on page 8 of the action mailed April 13, 2001.